

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Heidi RIEDEL et al.

Confirmation No. 7321

Group Art Unit: 1617

Serial No. : 10/016,964

Examiner: Kantamneni, Shoba

Filed : December 14, 2001

For : SELF-FOAMING OR FOAM-LIKE PREPARATIONS

REPLY BRIEF UNDER 37 C.F.R. § 41.41(a)(1)

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Appeal Brief - Patents
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This Reply Brief is in response to the Examiner's Answer mailed November 16, 2007, the period for reply extending until January 16, 2008.

In the Examiner's Answer, the grounds of rejection set forth in the final rejection with the exception of the rejection of claim 42 under 35 U.S.C. 102(b) as being anticipated by Marilyn (WO 92/16188) are maintained.

Appellants note that the Examiner's Answer does not sufficiently address several of Appellants' arguments as to why the rejections are without merit, and misrepresents some of the facts. These deficiencies have prompted the present Reply Brief.

Appellants also note that this Reply Brief is being filed under 37 C.F.R. § 41.41(a)(1) and is directed to the arguments presented in the Examiner's Answer, and therefore must be entered unless the final rejection is withdrawn in response to the instant Reply Brief.

In order to avoid repetition, the following response to the Examiner's arguments in the Examiner's Answer will be limited to issues which in Appellants' opinion are important enough to warrant a further comment. Accordingly, Appellants' silence with respect to any allegations set forth in the Examiner's Answer which are not specifically addressed below should by no means be construed as Appellants' admission that these allegations are of any merit.

REPLY

1. Appellants note that the Examiner takes the position that the rejection of claims 18-22, 28-33, 35, 42 and 43 under 35 U.S.C. § 102(b) as allegedly being anticipated by Beutler et al., U.S. Patent No. 4,808,388 (hereafter "BEUTLER") should be affirmed. In this regard, the Examiner again relies predominantly on Examples 4/2 and 7/2 of BEUTLER (which clearly do not anticipate any of the rejected claims) and general concentration ranges from the specification of BEUTLER. The Examiner has however, again failed to demonstrate that the subject matter of any of the present claims is disclosed by BEUTLER with sufficient specificity. In other words, the Examiner has not explained where the specific combination of elements recited in the rejected claims is disclosed by BEUTLER in such a manner that one of ordinary skill in the art would envisage this specific combination.

Appellants note that at page 11, first paragraph of the Examiner's Answer the Examiner refers - for the first time - to Examples 5/1a and 5/1b of BEUTLER, asserting that these Examples anticipate some of the rejected claims in that they allegedly disclose compositions which comprise emulsifiers A to C in a total concentration of from 2 % to 20 % by weight.

In this regard, it is pointed out that in Example 5/1a of BEUTLER "Polysorbate 20" is identified as "Sorbitan monolaurate", not as PEG 20 sorbitan monolaurate as alleged at page 11

of the Examiner's Answer. (Non-ethoxylated) sorbitan monolaurate does not qualify as emulsifier B as recited in the present claims.

Further, even if one were to assume, *arguendo*, that the "Polysorbate 20" of Examples 5/1a and 5/1b of BEUTLER is in fact PEG 20 sorbitan monolaurate as alleged by the Examiner, it is far from certain that the corresponding compositions comprised from 1 % to 90 % by volume, based on the total volume of the compositions, of N₂O or CO₂, respectively (compare, e.g., present claim 18). Specifically, in columns 13 and 14 of BEUTLER it is set forth that the compositions of Examples 5/1a and 5/1b resulted in a foam which was "too liquid" and had an appearance that was "not within the proposed product properties according to the present invention".

In this regard, it is pointed out again that matter is "inherent" if the extrinsic evidence makes it clear that the matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Titanium Metals Corp. v. Banner*, 778 F.2d 775 (Fed. Cir. 1985); *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349-50 (Fed. Cir. 2002); *In re Crish*, 393 F.3d 1253, 1258-59 (Fed. Cir. 2004). Inherency, however, cannot arise from probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. To the contrary, a certain thing must result from a given set of circumstances to be inherent. *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

2. In the paragraph bridging pages 11 and 12 of the Examiner's Answer (relating to Appellants' arguments regarding the rejection of claim 42 under 35 U.S.C. § 102(b) over

BEUTLER) it is stated that “the Examiner need not point out any composition of BEUTLER which would not be self-foaming and or foam-like if it did not contain a combination of emulsifiers A to C.”

Appellants respectfully disagree with the Examiner in this regard. Specifically, present claim 42 recites, *inter alia*, that the method claimed therein comprises “rendering the preparation self-foaming and/or foam-like by incorporating into said preparation a total of from 2 % to 20 % by weight, based on a total weight of the preparation, of [emulsifiers A to C]”. In other words, according to claim 42 a composition without emulsifiers A to C which is not self-foaming and/or foam-like is rendered self-foaming and/or foam-like by incorporating therein from 2 % to 20 % by weight of emulsifiers A to C. Accordingly, in order to anticipate claim 42 BEUTLER would have to disclose (at least) a composition which is not self-foaming and/or foam-like without emulsifiers A to C and is self-foaming and/or foam-like upon incorporation therein of from 2 % to 20 % by weight of emulsifiers A to C. BEUTLER fails to disclose a composition which comprises from 2 % to 20 % by weight of emulsifiers A to C. The Examiner has not even identified any composition of BEUTLER which can reasonably be assumed to be not self-foaming and/or foam-like in the absence of emulsifiers A to C. For these reasons alone, BEUTLER fails to anticipate claim 42.

3. In the third paragraph of page 12 of the Examiner’s Answer (relating to Appellants’ arguments regarding the weight ratios of emulsifiers A to C which are recited in some of the rejected claims) the Examiner takes the position that “the compositions taught by BEUTLER

encompass the instantly claimed weight ratios”. Appellants respectfully disagree with the Examiner in this regard as well.

Specifically, BEUTLER does not even disclose separate concentration ranges for substances which qualify as emulsifier A and emulsifier C. Moreover, even if BEUTLER were to disclose three separate concentration ranges for substances which qualify as emulsifiers A to C and if one were to assume that these (theoretical) concentration ranges would “encompass” the instantly claimed weight ratios, it is submitted that “encompassing” these specific weight ratios is clearly not the same as actually disclosing these specific weight ratios in a sense that one of ordinary skill in the art would envisage these weight ratios.

4. Regarding the comments in the first full paragraph of page 13 of the Examiner’s Answer (relating to the rejection of claim 42 under 35 U.S.C. § 102(b) as allegedly anticipated by Penska et al., EP 0 938 890 (hereafter “PENSKA”)), Appellants point out that the Examiner has failed to provide any evidence that the compositions of Examples 6 and 7 of PENSKA relied on in the rejection are in fact self-foaming and/or foam-like and in addition has failed to provide any evidence that these compositions would not be self-foaming and/or foam-like in the absence of emulsifiers A to C (if one were to assume, *arguendo*, that they are self-foaming and/or foam-like in the presence of emulsifiers A to C) . In this regard, the comments under item 2. above are referred to.

5. Regarding the comments in the paragraph bridging pages 13 and 14 of the Examiner’s Answer (relating to the rejection of claims 18-24, 28-31, 34, 36-39, 42 and 43 under 35 U.S.C. §

P29927.A10

103(a) as allegedly being unpatentable over Bellon et al., FR 2,789,397 (hereafter “BELLON”)), Appellants note that the Examiner takes the position that “[t]he structure of PEG-100 stearate glyceryl stearate is $C_{17}H_{35}-COO(CH_2CH_2O)_{100}(CH_2-CH(OH)-CH_2-OOCC_{17}H_{35})$ ”. However, the Examiner has not provided any evidence which would support this allegation.

6. In the last paragraph of page 14 of the Examiner’s Answer the Examiner refers, for the first time, to Example 3 of BELLON which allegedly describes a shaving foam which comprises 4.00 % by weight of decylglucoside. In this regard, the Examiner appears to allege that decylglucoside qualifies as emulsifier C recited in the present claims, i.e., as a branched and/or unbranched, saturated and/or unsaturated fatty alcohol having a chain length of from 10 to 40 carbon atoms. However, it is apparent that decylglucoside does not at all qualify as a fatty alcohol but is glucose which is etherified with decyl alcohol. For this reason alone, the Examiner’s corresponding allegations are without merit as well.

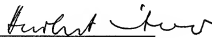
7. The Examiner has again failed to explain why despite the fact that BELLON does not contain any indication whatsoever that emulsifiers A to C recited in the rejected claims should be considered together as a combination of emulsifiers this document motivates one of ordinary skill in the art to optimize the total concentration of the of substances which qualify as emulsifiers A, B and C (and the weight ratios thereof).

CONCLUSION

The request to reverse the rejection of claims 18-43 and to return the application to the Examining Group for prompt allowance is respectfully maintained.

Although no fee is believed to be required for entry of this Reply Brief, the Patent and Trademark Office is hereby authorized to charge any fee that is deemed to be necessary to Deposit Account No. 19-0089.

Respectfully submitted,
Heidi RIEDEL et al.



Neil F. Greenblum
Reg. No. 28,394

Heribert F. Muensterer
Reg. No. 50,417

January 10, 2008
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191